

PATENT COOPERATION TREATY

KMC

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

BRUESS, Steven C.
Merchant & Gould P.C.
P.O. Box 2903
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ETATS-UNIS D'AMERIQUE

PCT

WRITTEN OPINION
(PCT Rule 66)

ATY RESP W.O.: Oct 27, 2004 *KE*

Date of mailing
(day/month/year) 27.07.2004

Applicant's or agent's file reference
758.1416WOU1 ✓

REPLY DUE within 3 month(s)
from the above date of mailing

International application No.
PCT/US 03/1867

International filing date (day/month/year)
07.10.2003

Priority date (day/month/year)
08.10.2002

International Patent Classification (IPC) or both national classification and IPC
B01D29/15

Applicant
DONALDSON COMPANY, INC. et al.

1. This written opinion is the **first** drawn up by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application
3. The applicant is hereby **invited to reply** to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.
4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 08.02.2005

Name and mailing address of the international preliminary examining authority:



European Patent Office
D-80298 Munich
Tel. +49 89 2399 - 0 Tx: 523656 epmu d
Fax: +49 89 2399 - 4465

Authorized Officer

Hoffmann, A

Formalities officer (incl. extension of time limits)
Ipinazar, P
Telephone No. +49 89 2399-8131



I. Basis of the opinion

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

Description, Pages

1-19 as originally filed

Claims, Numbers

1-17 as amended (together with any statement) under Art. 19 PCT

Drawings, Sheets

1/16-16/16 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

5. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

6. Additional observations, if necessary:

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**1. Statement**

Novelty (N)	Claims	1-4, 7-10, 12: no
Inventive step (IS)	Claims	5,6,11, 13-17
Industrial applicability (IA)	Claims	1-17

2. Citations and explanations**see separate sheet**

**WRITTEN OPINION
SEPARATE SHEET**

International application No. PCT/US 03/31867

D1: US-A-5 490 930 (KRULL TIMOTHY L) 13 February 1996 (1996-02-13)
D2: WO 95/09037 A (FLEETGUARD INC) 6 April 1995 (1995-04-06)
D3: GB-A-2 356 825 (DELPHI TECH INC) 6 June 2001 (2001-06-06)
D4: US-A-2 902 162 (HUMBERT JR KINGSLEY E ET AL) 1 September 1959 (1959-09-01)
D5: WO 97/37743 A (HYDAC FILTERTECHNIK GMBH ; MEES HARALD (DE); SAKRASCHINSKY
MICHAEL (DE) 16 October 1997 (1997-10-16)
D6: US-A-4 853 118 (BROWNELL PETER ET AL) 1 August 1989 (1989-08-01)
D7: DE 11 52 285 B (PUROLATOR PRODUCTS, INC.) 1 August 1963 (1963-08-01)

1. The claims should be provided with reference signs for the sake of clarity of the claims, in particular claim 11.
2. The wording of the claims is quite different with regard to the original disclosure (l. a. for instance the definition of the "ledge") so that there are doubts that they are really within the original disclosure (Article 19 (2) PCT).

The Applicant is asked to show the original disclosure of the features (in particular the generalisations) of the claims in the next letter of reply.

3. For not retarding the examination of the claims with regard to Article 33 PCT, the following statements are given under the condition that the Applicant has shown the original disclosure.
4. If the embodiment of Figure 1 of the present application falls under the scope of claim 1, than also the disclosure of Figure 1 of D1 falls under the scope of claim 1.

The roll seam in D1 forms also an inwardly extending ledge as defined in claim 1. Thus also the embodiments of Figures 2, 4, 5, 6, 8 fall under the scope of claim 1.

Thus D1 discloses the features of present claims 1-4, 7-10 and 12 (Article 33 (2) PCT).

The other claims lay within the knowledge of the skilled person of D1 with regard to the respective underlying problem to be solved.

5. For the formulation of new claims the Applicant is asked to consider also the other X-documents of the Search Report, since the next official communication will be the IPER.

PATENT COOPERATION TREATY

KCW

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To:

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ETATS-UNIS D'AMERIQUE

WRITTEN OPINION

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ATY RESP W.O. : JAN. 15, 2005 *KCW*

Date of mailing
(day/month/year)

15.11.2004

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Authorized Officer

Hoffmann, A

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Fuerbass, C
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WRITTEN OPINION

International application No. PCT/US 03/31867

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1-19 as originally filed

Claims, Numbers

1-18 received on 25.10.2004 with letter of 25.10.2004

Drawings, Sheets

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6. Additional observations, if necessary:

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**1. Statement**

Novelty (N)	Claims	1-18: yes
Inventive step (IS)	Claims	1-14: yes; 15: no
Industrial applicability (IA)	Claims	1-18: yes

2. Citations and explanations**see separate sheet**

POINT V:

D8 = US-A-3397789

D9 = US-A-3232437

The documents D8 and D9 were not cited in the international search report. Copies of the documents are appended hereto.

1. The arguments of the applicant concerning the claims 1 -14 are convincing.
2. The subject matter of claim 15 is not directed to the same inventive filter element as claim 1 (missing the features (a) (i) and (ii) of claim 1). Thus an objection according Rule 13.1 could be raised in a national phase under the corresponding national patent convention.

The subject matter of claim 15 does not fulfil the requirement of article 33 (3) PCT.

The method of claim 15 may concern only intermediate steps for making a filter, as can be explained by D8 or D9:

In D8 or D9 the filter element is introduced in to an open end of a housing with one closed end and one open end. The end cap of the filter element is provided with projections which center the filter element within the housing and which is engaged with an outwardly extending circumferential ledge extending completely along an internal surface of the housing. The engagement of the projections with the ledge is on that side of the ledge which directs to the open end side of the housing.

The skilled person is thought by D8 or D9 to engage the projections with a ledge of the housing to center the filter element. Is does not seem to justify the involvement of an inventive step to provide an inwardly extending ledge instead of an outwardly extending ledge with the same purpose to center the filter element.

3. If **however** the subject matter of a method claim would be directed to an engagement of the projections on that side of the ledge which directs to the closed end of the housing, the involvement of an inventive step could be acknowledged.

**WRITTEN OPINION
SEPARATE SHEET**

International application No. PCT/US 03/31867

In each case this proposition of a method claim is the real teaching of the present application.